



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/024,885	02/17/1998	DAVID ROTH	T1680CIP2	8884

7590

12/04/2002

Marc C Van Ness
Blakely Sokoloff Taylor & Zafman
12400 Wilshire Blvd
Seventh Floor
Los Angeles, CA 90024

EXAMINER

ABRAMS, NEIL

ART UNIT

PAPER NUMBER

2839

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/024885

Applicant(s)

W

Examiner

Group Art Unit

2839

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9-30-02 (CPA and prelim amdt).
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 80-85, 94, 117-132 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 2839

The request for continued prosecution is acknowledged. A first action follows.

Spec. Page 59, line 11 is unclear.

Last amendment on pages 3, 4 includes two claims number 120. To correct this the Examiner has renumbered the first claim 120 as claim 132. Applicants should also change their copy. Pages 4, 5, 6 now include claims 120 through 131. Any new claims to be submitted should start with claim 133.

For claims 123, 130, 131 are dependencies correct? Claims 127, 128 dependencies are incorrect. All claim dependencies should be reviewed and corrected as necessary.

Claims 124, 129, lines 1, 2 of each should "receptacle" be -- receptacle module --?

Applicant appears to assert that the claims of this case are based on material disclosed in parent case 5,411,405 and receive benefit of priority date of Nov 12 1993. Is this correct?

Note that all claims in this case must be directed to elected embodiments of figs 22-25.

In remarks applicant should relate *claims to specific figures*.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 2839

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

117
Claims 80-85, 94, 117-120 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-20 of U.S. Patent No. 6,164,989 to Glad et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this case are broadened variations of the patent claims which are also basically to a card body and receptacle module though stated using different terms.

> Claims 80-85, 94, 117-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldous 404 in view of Siemon, Hardesty, Clark, Ingalsbe^{and} Research Disclosure (RD).

For claim 80, note Aldous fig 7; it would have been obvious to form parts 52, 54, 50, 30 as a single unit (receptacle module) to plug into socket 46 since adapter use is well known as shown by Siemon, Hardesty, Clarke, RD and Ingalsbe.

This would enable omission of cord 54, use of plural plugs (Hardesty) or addition of a circuit component as in RD or change of plug in direction as in Hardesty, fig. 2 and RD. Also for

Art Unit: 2839

Aldous, fig 8, it would have been obvious to use a receptacle module in view of Hardesty. Clark and RD for reasons noted above, the module being plugged into card 40 recess 36.

For claim 85, Hardesty, figs 1, 2, 3, 6A are applied.

For claim 118, obvious to use a pivoting or hinged cover in view of Siemon, fig 10. For claims 132, 120 obvious to use one ^{of} the added recesses (Hardesty at 54, 54") for a known wireless device.

For claim 121 obvious to include Aldous DAA 50 in the adapter.

For claims 122, 124, Aldous, fig 10 part 72 forms a sliding drawer. Obvious the drawer would closely receive a plug.

Claims 124, 126, 128, 131 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aldous 404.

All recited features disclosed; see sliding drawer 72 and fig 20, movable bottom 160.

Claims 129 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beckham 5338210.

Note figs 23, 24, jaws 72, 210. Compare to applicant's fig. 25.

Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. For most claims, Aldous, figs 7, 8 are relied upon. Basically obvious to form 52. 36 as a single adapter for convenience ^{or} to use an adapter (module) with fig. 8 card 40. In addition to reasons noted above this would enable other designs of plugs to be used and would save wear on the card receptacle 36.

Application/Control Number: 09/024,885


Page 5

Art Unit: 2839

Any inquiry concerning this communication should be directed to N Abrams at telephone number (703) 308-1729.

N ABRAMS/pj

11/29/02


NEIL ABRAMS
EXAMINER
ART UNIT 322